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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,174	05/15/2001	Martyn Ian Butterworth	13344-9025-00	1570
23409 7590 07/07/2009 MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVENUE Suite 3300 MILWAUKEE, WI 53202				
EXAMINER				
JANVIER, JEAN D				
ART UNIT		PAPER NUMBER		
3688				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/858,174

Applicant(s)

BUTTERWORTH, MARTYN IAN

Examiner

JEAN JANVIER

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-8 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8 and 18-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/IC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/14/09 has been entered and a Non-Final Action follows.

Response to Applicant's Arguments

Applicant's arguments with respect to claimed invention have been considered but are moot in view of the new ground(s) of rejection.

Claim Status

Claims 1, 4-8 and 18-25 are pending in the Application, while claims 2-3, 9-17 and 26-34 have been canceled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-8, 18 and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gregorek, USP 5,428,670.

As per claims 1, 4-8, 18 and 21-25, Gregorek discloses a marketing system for selectively modifying an existing communication network (such as a telecommunication network) by modifying a portion of a processing software, which permits replacing at least a portion of a call progress signal generated by the communication network by a generally continuous pre-recorded announcement, such as advertisements (in text and/or audio/video format). A first station (telecommunication apparatus) is provided for placing a call, by a calling party or caller, at a first network address to send an (audio) message to a called party or recipient. The (telecommunication) network is adapted for connecting the call, from the caller, to an identified called station of the recipient at a second network address (establishing a connection with the telecommunication apparatus or called station of the recipient), the called station of the recipient (telecommunication apparatus) having either a busy status (unavailable) or an idle status (available). The network is configured to initially determine the busy/idle status of the called station and if the called station has an initial busy status, then the network or system checks the busy/idle status of the called station at predetermined intervals for an idle status. A player plays/displays at least one generally continuous announcement (or supplementary image or advertisement) to the calling party for a predetermined period of time during a time period when a call progress signal (conventional audio/visual) would have been provided to the calling party after the call was placed (playing/displaying a supplementary image or announcement or advertisement after the caller places a call to a called recipient and the recipient's station is in idle status, wherein the announcement replaces a conventional ring-back signal or audio/visual message played at the caller's station and terminating the supplementary message when the recipient answers or picks up the phone). The player (system) determines the announcement

(supplementary image) to be played (displayed) based upon criteria established exclusively by the marketing system (e.g. advertiser) and independently of the identity of the called station. The playing of the announcement (supplementary image) is **terminated** and the call is completed to the calling station, in the case of the calling station having an initial idle status, when the called station or the telecommunication apparatus of the call recipient responds by answering the (incoming) call from the caller or calling party (terminating the playing/displaying of the announcement or supplementary image when the called station answers the incoming call after the connection has been established). It is herein understood that both the caller's station and the recipient's station are configured to receive and transmit audio/visual (mixed media audio/video) information or messages. (See abstract; col. 1: 12-20; col. 1: 53 to col. 2: 54; col. 3: 11-50; col. 7: 1-10; col. 7: 54-59; col. 9: 14-22; figs. 1 and 3-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek, USP 5,428, 670 in view of Gabbard, USP 6,205,432.

As per claims 19-20, Gregorek does not disclose that the caller inserts a supplementary image (ad) into the message sent to the recipient, and if the message is a text messaging, then the

supplementary image is inserted in part of the message from the caller and will be visible to the recipient on retrieval (receipt) of the (text) message.

However, Gabbard discloses an advertisement system and method for inserting into an end-user's communication message or e-mail a background reference to an advertisement. The background reference causes an advertisement image to be tiled or watermarked across an end-user screen behind the text of an e-mail message (or public posting) that will be sent from the user or sender to another user or recipient. A message server inserts the background reference (ad) after receiving a message or an e-mail (text message) originally sent from an end-user originator (sender) and before sending the message to be delivered to an end-user recipient (recipient). When necessary, the message server will convert at least a portion of the message into a proper format, such as HTML, before inserting the background reference to an advertisement, which is preferably selected in accordance with end user recipient demographic information and/or ad exposure statistics. The advertisement itself, often a graphical file, is preferably not transmitted with the message, but is typically stored at the message server or other location remote from the end-user recipient. Preferably, the message server maintains and refers to records on each end-user recipient to allow for selective enablement of background reference insertion and overwriting based upon end user preferences. According to various "non-web" example embodiments, the message server transmits an SMTP, POP3 or NNTP message with an HTML portion for a respective HTML-compatible client. In other "web-based" example embodiments, the message server transmits the entire message in HTML to be used as a stand-alone web page or as a portion of a larger page employing frames or tables (see abstract).

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the teachings of Gabbard into the system of Gregorek so as to send by a sender/caller a message, text message or e-mail message to a recipient, via a communication network or telecommunication system, wherein a server is configured to insert a targeted advertisement (supplementary image) into the text message or e-mail message before the text message or e-mail message is delivered or played/displayed to the caller or recipient, thereby taking advantage of a text message or e-mail message sent, by a sender/caller, to a recipient to present to the recipient a targeted ad (supplementary image), based on the recipient's profile, inserted into the e-mail message before it is delivered to the recipient, while enabling the owner of the communication or telecommunication system to raise important funds or revenue by charging the advertiser, associated with the inserted targeted advertisement, a fee for presenting or displaying/playing his advertisement to the recipient of the sender's/caller's text message or e-mail.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP Re. 34,380 to Sleevi discloses a telecommunication network, a system for applying messages or data to the customer lines of calling parties or callers during the (conventional) "ringback" period of telephone call set up. The messages are preferably applied between successive ringback tones during the ringback period and are terminated when the called party or recipient answers the (incoming) call from the caller (terminating the supplementary images when a connection is established between the caller's device and the recipient's device or the

recipient answers the call). Advertising messages, civic or company announcements, political messages, informational messages (e.g. news or weather), or other data can be transmitted on the telephone lines during what is otherwise essentially unused times when the line is already tied up (See abstract).

USP 5,652, 784 to Blen discloses a telephone advertising service for providing a short advertising message through a telephone receiver as a telephone call is initiated. The advertising message is stopped after a predetermined run time, and an invitation-to-dial tone is added. The advertising message is stopped when a subscriber starts to dial numbers. The method provides the advertising messages in lieu of invitation-to-dial tones. Differentiated subscribers are individually provided with distinct advertising messages. Subscribers are distinguished by characteristics of exchange number, monthly call volume, call type, geographical location and time of day. The advertising messages are provided by a message system rack connected to a digital or analog telephone exchange. Each rack has plural message recorders and plural cards connected to multiple users. Software controls a connection network. Subscriber lines are sampled to sense when a call is being initiated and to signal to a controller that a telephone call is being initiated. A PCM audio interface is activated. An available message channel is switched to the subscriber line, and a corresponding message is played over the subscriber line. Soon the subscriber line is connected to the telephone exchange, and an invitation-to-dial tone is provided. Several different messages are offered in different sets of channels, changing the messages depending on the time of day. When a prohibit service signal is active, the subscriber line is switched directly to the telephone exchange (See abstract).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

07/04/09

/J. J./

/Jean Janvier/

Primary Examiner, Art Unit 3688